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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,566	12/05/2003	Cord F. Stahler	2923-593	7975
6449 7590 01/07/2010 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
GROSS, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
1639				
NOTIFICATION DATE		DELIVERY MODE		
01/07/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

### Office Action Summary

**Application No.**

10/727,566

**Applicant(s)**

STAHLER ET AL.

**Examiner**

CHRISTOPHER M. GROSS

**Art Unit**

1639

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39 and 41-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39 and 41-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
- Paper No(s)/Mail Date 10/5/2009

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The examiner on the present case has changed. See contact information below. Responsive to communications entered 2/6/2008. Claims 39 and 41-55 are pending. Claims 39 and 41-55 are under consideration.

#### ***Priority***

This application, 10/727,566, filed 12/5/2003, states that it is a divisional of 09/763,914, filed 5/11/2001, now US Patent 7,097,974, which is the national stage under 35 USC 371 of PCT/EP99/06317, filed 8/27/1999. This application states a claim for foreign priority to Germany priority documents : 1998DE-198 39 254.0, filed 8/28/1998; 1998DE-198 39 255.9, filed 8/28/1998; 1998DE-198 39 256.7, filed 8/28/1998; 1999DE-199 07 080.6, filed 2/19/1999; and 1999DE-199 24 327.1, filed 5/27/1999.

#### ***Withdrawn Objection(s) and/or Rejection(s)***

The rejection of claims 39 and 41-44,46-54 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is hereby withdrawn in view of applicant's amendments.

#### ***Maintained Objection to the Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The

following claims state the following terms which are not recited in the specification as filed. : Claim 45 states the words "negative receptors".

*Response to Arguments*

In the paragraph bridging pp 7-8 of the remarks entered 2/6/2008, applicant argues the term negative receptor finds explicit support in the originally filed claims and further that the exact language (*ipsis verbis*) of used in the claims need not appear in the specification.

In this vein it is noted that the present objection does not concern "new matter" under 35 USC 112 first paragraph. The examiner agrees that "negative receptors" appeared in the application as filed.

The present objection however concerns the meaning of "negative receptors" for which neither explicit (*ipsis verbis*) or implicit may be found in the specification. According to 37 CFR 1.75(d)(1), the claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Here, despite applicant's assertion, the examiner does not find implicit support for the meaning of "negative receptor." See also 35 USC 112 second paragraph rejection below.

If applicant believes this assessment is in error, in response to this office action, applicant must point to where in the specification the meaning of "negative receptor" is conveyed, specified as to page and line.

***Maintained Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 45 recites the limitation "any negative receptors" in line 3. There is insufficient antecedent basis for this limitation in the claim anywhere in the application and/or claim 45 recites vague and indefinite language in "any negative receptors". To one of skill in the art, it is not clear what constitutes a receptor being negative: does negative refer to charge, lack of ligand binding, rotation of polarized light, etc. It is further noted that the specification does not provide a definition for "negative receptor" and in accordance with MPEP 2173.02: If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

***Maintained Claim Rejection(s) - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39, 41-46, 48, 49, 53 and 54 plus 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Heller et al., US 5,605,662 A for the reasons set forth in the office action mailed 8/6/2007.

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Please note that the above rejection has been modified from the original version to more clearly address applicants' newly amended and/or added claims and/or arguments. With regard to new claim 55a claim, Heller et al teach fabrication on glass (at least partially transparent) in column 10 lines 5-44 as was mentioned in the last office action on p 9.

#### *Response to Arguments*

In the remarks entered 2/6/2008 applicant argues not all elements are taught.

Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

In the paragraph bridging pp 8-9 of the response, applicant asserts that Heller et al do not teach (i) light directed synthesis of polymeric receptors; (ii) transparent supports.

(i) In response to applicant's argument concerning light directed synthesis it is noted claim 39c is drawn to photoactivating predetermined positions, the...analyte determination being carried out on an integrated apparatus, which giving the claims the broadest reasonable interpretation reads on a fluorescence excitation, which Heller et al discuss in column 5 lines 60-64; column 7 lines 61-66 and column 20 lines 40-52, as was mentioned in the last office action in the paragraph bridging pp 8-9.

Accordingly, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., photolysis) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(ii) In regard to transparent supports, applicant's attention is respectfully invited to column 10 line 10 where Heller et al teach fabrication on supports such as glass.

***Maintained Claim Rejection(s) - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39 and 41-54 plus 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller et al., US 5,605,662 A and Wrinkler et al., US Patent 5,677,195, (of record) for the reasons set forth in the office action mailed 8/6/2007.

\*\*\*

Please note that the above rejection has been modified from the original version to more clearly address applicants' newly amended and/or added claims and/or arguments. With regard to new claim 55a claim, Heller et al teach fabrication on glass (at least partially transparent) in column 10 lines 5-44 as was mentioned in the last office action on p 9.

*Response to Arguments*

Applicant does not offer further arguments regarding the above obviousness rejections beyond what was set forth with regard to the 35 U.S.C. § 102 rejection, above. To the extent that Applicant is merely repeating their previous argument, the Examiner contends that those issues were adequately addressed in the above sections, which are incorporated in their entireties herein by reference.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER M. GROSS whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571 272 0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross  
Examiner  
Art Unit 1639

cg

/ Christopher S. F. Low /  
Supervisory Patent Examiner, Art Unit 1639